



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/350,983	07/09/1999	MARC PORAT	040180-0002	9089

7590

08/27/2003

RONALD S LAURIE
SKADDEN ARPS SLATE MEAGHER & FLOM
525 UNIVERSITY AVENUE
PALO ALTO, CA 94301

EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/350,983

Applicant(s)

PORAT ET AL.

Examiner

JAGDISH N PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70,74-101 and 106-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 74 and 75 is/are allowed.
- 6) ☒ Claim(s) 1-70,76-101 and 106-112 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3624

DETAILED ACTION

1. This communication is in response to amendment filed 6/9/03.

Response to Amendment

2. As per earlier communication and agreement with the applicant, the examiner has removed Huberman as prior art in rejection of claim limitation (d) "automatically generating rating information..". According all rejection of claims based upon application of Huberman reference suggesting the aforementioned limitation has been withdrawn. However, claims have been rejected in view of new refernce(s) as discussed in the following paragraphs.

Claims 1-70, 74-101 and 106-112 are pending. Claims 74-75 are allowed as per earlier office action.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Art Unit: 3624

4. Claims 1-15, 18-29, 30-33, 37-56, 62-70, 76, 78-82, 101 and 109-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alaia et al. US 6,408,283) (Alaia) and further in view of article: Boston Ed RFP Seeks Between 132 MW and 306 MW; Independent Power Report, October 25, 1991 (Boston Ed).

5. Claim 1: Alaia discloses a fully automated method of facilitating an electronic auction between a prospective buyer and a plurality of prospective sellers with near perfect information (abstract), comprising:

a) inputting into a computer a buyer's request for offer (Fig.1 buyer 10, col. 55-57, product or service be defined by a buyer);

b) communicating the request for an offer to at least two of the sellers (col. 3 L 8-17, request is communicated to potential suppliers, 30);

c) receiving offers, including terms of sale in response to the request for an offer, from at least two of the sellers (col. 3 L 18-24, bidders (suppliers) submit bids 58..., terms and conditions are indicated as ..RFQ which include specifications 50..);

Art Unit: 3624

e) communicating information regarding at least some of the seller offers to at least one other seller (Fig. 8 shows information regarding sellers (bidders) offers);

f) receiving an adjusted offer from at least of the seller during a specified auction period (col. 4 L 4-13, ..participating bidder to see and begin planning their competitive responses);

g) communicating information regarding at least some of the seller offers and at least part of the rating information to the buyer; (refer to Fig. 8 which shows bidder offer and price information of the bid which is part of the rating information).

Alaia, fails to teach steps d) automatically generating rating information about the seller offers and receiving and communicating the (rating) information to at least one other seller. Boston Ed in the same field of endeavor, however, teaches a method of generating rating information about seller offers based on a plurality of predetermined criteria (refer to paragraph "under the scoring system, price makes up 160 of the 364-point maximum score. The bids will also be ranked according to economic confidence.., development confidence,..operational longevity and system optimization"). Boston Ed, however, fails to teach that the generating rating information about seller's

Art Unit: 3624

bids (offers) is automatically performed as per claimed invention.

It was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of generating rating information about seller offers based on a plurality of predetermined criteria gives you just what you would expect from the manual step as shown in ~~Reference~~ ^{Boston Edison} A. In other words there is no enhancement found in the claimed step. The claimed generating rating information only provides automating the manual activity. The end result is the same as compared to the manual method.

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate steps of automatically generating rating information about the seller offers into the method disclosed by Alaia because generating rating information about the seller offers would allow the buyer to evaluate the offer not just on the basis of price alone but also based on other critical considerations such as the sellers creditworthiness, experience level for delivering the offered product or services which are commonly evaluated by a buyer in

Art Unit: 3624

conjunction with the competitive pricing at which the product is offered. Furthermore, communicating the information regarding the seller offers to other seller(s) would enable the seller to respond to current bids in association with the rating of the offers from other seller(s).

6. Claim 2: Inputting...a buyer's request for information about products or services..(Alaia, refer to RFQ phase, col. 3 L 9-24);

Finding information in response to the request (Alaia, bids 58 taken against individual lots with RFQ col. 3 L 9-24);

Communicating at least part of the information found to the buyer (Alaia, the Auction Administration phase.. coordinates the auction and administers the auction setup and preparation col. 3 L 9-29);

Communicating information regarding ..seller offers and at least part of the rating information to the buyer Fig. 8 shows information regarding sellers (bidders) offers);

All other limitation have been analyzed per claim 1.

7. Claims 3-6 are customary steps to aid the buyer in communication and/or presenting product information and are old and well-known steps and official notice is taken to that

Art Unit: 3624

effect. Various protocols and arrangements for electronic shopping as recited in claims 3-6 are variations obvious to those skilled in the art. Refer to claim 2 for motivation.

8. Claim 7-11: the computer is operated by a service provider unrelated to ..the buyer or the sellers (Alaia coordinator 20, shown in Fig. 1), independent destination on the WWW (web site of the coordinator (ex. Freemarket.com), this also is third party service. Various business arrangements recited in claims 10 and 11 are obvious and well-established business practices. For example, providing service on an out-source basis wherein a service provides acts as a primary contractor and hires a third party to acquire products or render services because of economical considerations.

9. Claim 12-15: inputting the request using graphical user interface with other related features recited are inherent to online auction wherein the auction is implemented via a web site of the provider as discussed in Alaia col. 3 L 61-63.

10. Claims 18-29: a plurality of criteria concerning buyer preferences (inherent feature of RFQ (Request for Quotation)).

Art Unit: 3624

It would have been obvious to one of ordinary skill in the art at the time of invention to implement a plurality of criteria concerning buyer preferences because this would allow the buyer to select his/her preferred choice of payment methods, shipping methods etc. are obvious variations of criteria or constraints concerning buyer request which include desired product, seller, transfer, payment characteristics and are anticipated by the cited art in a similar manner.

11. Claims 30-32, 77: wherein said request includes asking sellers to apply a suggestion module to said request (Alaia, col. 2 L 55-66, specification 50 for a desired product is a document that not only stipulate the buyers requirement regarding the products and services but also solicit information from the potential sellers whereby the sellers would provide suggestions to buyer regarding similar or alternative products, shipments, delivery schedules etc.).

Claim 33: buyer remains anonymous to said prospective sellers (Alaia, col. 4 L 43-46, the information that can be displayed by the client application as shown in Fig. 6A-6D).

Claim 37: a software process initiates the communicating the request...(Alaia Fig. 2 and 3, col. 3 L 9-17).

12. Claim 38-46: communicating information about the buyer to at least one of the sellers (Alaia, col. 3 L 3-8, suppliers receive notices regarding upcoming auction as well as client software), ..in consideration to the buyer (Alaia, col. 3 L 3-8, suppliers participate in the buyer's auction).

13. Claims 47-50: cited references Alaia fail to explicitly disclose various forms of rating information. However, ranking of merchants, vendors and service providers in many different forms is old and well known. For example, out-sources vendors are ranked by a numerical score for each category of product or service they provide. It is stated that broadly interpreted, rating of vendors as disclosed by Boston Ed cover all variations of rating information claimed herein.

14. Claim 51-52: seller information includes identity of the offerer (inherent to Alaia because the offerers (sellers) communicate with to auction brokers).

15. Claim 53-54 and 109-111: communicating of seller offers and rating information takes place during auction period (Alaia, auction period is indicated by Fig. 9A). Other variations of this step such as "before" and "after" the auction period are

obvious to those skilled in the art as such knowledge is widely available in marketing art.

Claims 109-111 are similarly analyzed.

16. Claims 55-56: the recited claims pertain to selling offering purchase history information of consumer for marketing.

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement these steps for marketing and maximizing revenue from the operation of the auction.

Claim 62: time remaining in the specified auction period (Alaia Fig 7A time line, col. 63-66).

17. Claims 63-68: buyer's auction includes specified auction parameters (Alaia Fig. 6A-9B).

18. Claims 69-70: adjusted offer expires after a time period specified by the offerer (Alaia schedule close, Fig. 7A, time period is 10:30 Hours), time specified by the offerer (time specified is 10:30).

Claim 76: ..side by side comparisons of a plurality of seller offers (Alaia, Fig. 8, refer to BIDDER and BID AMOUNT).

Art Unit: 3624

19. Claims 78-82: adding information about the auction to a database (Alaia, refer to Figures 6A-9B elements of database recited in dependent claims).

Claims 101: communicating an acceptance by the buyer..(inherent to any auction and therefore, Alaia method).

Claim 112: corresponds to and analyzed as in method claim 1.

20. Claims 34-36 and 106-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alaia and Boston Ed as applied to claim 1 and further in view of Walker (US 6,041,308).

Claims 34-36: Alaia or Boston Ed fail to explicitly teach that communicating of request for an offer includes searching a database for offers corresponding to the request (Walker, Fig. 2, offer database 500), However, searching a database and Pre-compilation of database and compilation on the fly are old and well methods of database generation and updates and obvious to one of ordinary skill the art.

21. Claims 106-108: Alaia and Boston Ed fail to teach, however, Walker, in the same field of endeavor, teaches a method of electronic shopping which comprises the step of automatically generating rating information about seller offers after the step of receiving adjusted offer (col. 4 L 21-24, eligibility criteria).

It would have been obvious to have the rating the seller offers before and after receiving an adjusted offer because it would enable the buyer to monitor the trend of rating information available during the course of the auction for each seller.

23. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alaia and further in view of Boston Ed as applied to claim 1 and further in view of Chen (US Pat. 65,991,737) (Chen).

Claims 16-17: Alaia and Boston Ed fail to teach, however, Chen, in the same field of endeavor, teaches a method of electronic shopping wherein a purchase request is input using a voice user interface (inherently includes natural language input) (Chen Col. 4 L 61- col. 5 L 16).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the method of claim 1 as disclosed by Alaia in view of Boston Ed provide for input using a voice interface and further including natural language input per Chen reference because this would facilitate ordering of bidding in an interactive auction easier and faster than inputting via a typing the required inputs.

Art Unit: 3624

24. Claims 57-61 and 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alaia and further in view of Boston Ed as applied to claim 1 and further in view of Mori et al. (EP 0 828 223 A2) (Mori).

Claims 57-61: Alaia and Boston Ed fail to recite and Mori recites that the adjusted offer is adjusted at least in part by a computer algorithm (see abstract, and Figure 1).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the computer algorithm per claims 57 including various features recited in dependent claims 58-61 because providing capability of computer algorithm for adjusting offers and using conventional rules and procedures by computer would make it unnecessary for the bidder to stay before the auction terminal and would allow more accurate and timely entry of auction information.

Claim 106: the step of automatically generating rating information occurs before the step of receiving an adjusted offer (inherent to Boston Ed because, the rating is generated before adjusted offers are received).

25. Claim 83-94: Note that all limitations have been analyzed per claim 1 except limitation reciting "selling information about the auction". Note that the "selling" of information as recited has no dependence on the method of conducting auction

Art Unit: 3624

recited in steps a) - g) and therefore the limitation is analyzed as such.

Both Alaia and Boston Ed are silent about selling auction information. However, official notice is taken that the concept of selling purchase history database by entity who compiles it is old and well known in marketing. For example a business entity might desire to target consumers in certain geographic area with certain purchasing habits for sale of service or products. A small business entity (telemarketing for example) may purchase such commercial database containing appropriate consumer profiles (including demographical data) and purchase history for target marketing.

Claims 95-100 are similarly analyzed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Newsbytes article dated Jan 15, 1999: "Ebay Thwarting Fraudsters" discloses transaction feedback rating of bidders based on their bidding activity.

Art Unit: 3624

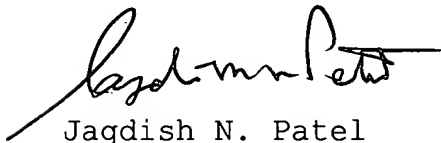
Klingman (US Pat. 5,950,172) teaches on-line rating system based upon consumers' satisfaction related to products purchased electronically.

Harrington et al. (US Pat. 6,161,099) teaches an apparatus for conducting auctions over electronic networks wherein an auctioneer maintains a web site that allows the user to participate in the auction by accessing the web site. Harrington, in particular, suggests automatic ranking and rating of bids received to determine best bids.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.



Jagdish N. Patel

(Examiner, AU 3624)

8/23/03